

REMARKS

Applicants respectfully request entry of the foregoing and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. § 1.112, and in light of the remarks which follow.

Claims 9-10 are pending in the application, claims 1-8 having been canceled above.

By the above amendments, the specification has been amended in accordance with 37 C.F.R. §1.804(a), to identify Applicants deposit of the claimed strain "*Bacillus sp.* IICT01." It has been decided that the addition of information designating the depository, accession number, and deposit date of deposited biological material after an application's filing date does not violate the prohibition against new matter. See *In re Lundak*, 773 F.2d 1216, 227 USPQ90 (Fed. Cir. 1985) and M.P.E.P. §2406.01. Applicants also canceled claims 1-8 because these claims are directed to non-elected subject matter.

Turning now to the Official Action, claims 9-10 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. For at least the reasons that follow, withdrawal of the rejection is in order.

Applicants understand that the Official Action takes the position that the specification is not enabling for the claimed compound because the specification does not include sufficient physical intrinsic properties such as "molecular weight, boiling point, melting point, etc." See Official Action at page 3. In response, Applicants have deposited the new strain "*Bacillus sp.* IICT 01" at the Imtech Depository, in Chandigarh, India, which Applicants submit is a depository recognized under the Budapest Treaty. Applicants

have deposited the strain using the same name and strain number used in the specification. The strain has also been identified by C.A.B. International Mycological Institute using specimen no. 5I (5-9-88) Herb. IMI No. B12681. A copy of the identification report is attached hereto for the Examiner's convenience.

Applicants submit that this deposit satisfies the requirements of 35 U.S.C. § 112, first paragraph, and has been made in accordance with 37 C.F.R. § 1.803.

In particular, it has been decided that § 112, first paragraph, does not require access to a microorganism deposit as of the filing date, but instead only requires assurance of access (to the microorganism culture by the public upon issuance of a patent on the application) prior to or *during* the pendency of the application, so that, upon issuance of a U.S. patent on the application, "the public will, in fact, receive something in return for the patent grant." (emphasis added) See *Feldman v. Aunstrup*, 517 F.2d at 1355, 186 USPQ at 112-13 (CCPA 1975) (quoting *In re Argoudelis*, 434 F.2d at 1394 (CCPA 1970) (Baldwin, J., concurring)).

Applicants further submit that if one were to perform the process steps disclosed in the specification using the deposited microorganism, one would obtain the β -keto aliphatic acid ester having the spectral properties defined in claims 9 and 10.

Absent any evidence to explain why the Patent Office doubts the accuracy of Applicants' statements regarding enablement of the claimed invention, Applicants submit that the invention of claims 9 and 10 is sufficiently enabled.

For at least these reasons, Applicants submit that the requirements of § 112, first paragraph, have been met. Applicants respectfully request reconsideration and withdrawal of the rejection.


From the foregoing, Applicants earnestly solicit further and favorable action in the form of a Notice of Allowance.

If there are any questions concerning this paper, or the application in general, Applicants invite the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

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Attachment: CAB International
Mycological Institute
Identification Report



C.A.B. INTERNATIONAL Mycological Institute

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Identification Services

REPORT N° Bact 61/88/I1-A

16 December 1988

YOUR REF: Dr. J. Amnapurma
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| Specimen Number | Herb. IMI Number | IDENTIFICATION |
|--------------------|---------------------|--|
| SI (5-9-88) | B12681 | <u>Report from Dr. J.F. Bradbury</u> <u>Bacillus</u> sp., small celled; not a plant pathogen. |

While all reasonable care is taken to ensure the accuracy and reliability of an identification report prepared by the Institute, no liability can be accepted by the Institute, its members, staff or agents in respect of loss, damage or injury (whether fatal or otherwise), howsoever caused, which may be suffered as a result of the identification.